

REMARKS

I. Formal Matters

Applicant thanks the Examiner for initialing the references listed on form PTO-1449 submitted with the Information Disclosure Statement filed on September 7, 2000.

Additionally, Applicant thanks the Examiner for acknowledging the claim to foreign priority under 35 U.S.C. § 119(a)-(d) and for confirming that the certified copies of the priority documents have been received.

II. Claims

Claims 1-12 are all the claims pending in the application.

A. Rejections under §102.

Claims 1, 7, and 12 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Shobu (U.S. Patent No. 5,692,130, hereinafter "Shobu").

To be an anticipation rejection under 35 U.S.C. 102, the reference must disclose every element of the Applicant's claims. Shobu teaches a server-client type system that uses the D-channel to notify the called terminal that the two-channel mode is to be employed (*see* col. 4, ln. 62-64, Shobu). By contrast, the claimed invention teaches a notification means that determines when the predetermined amount of data limit has been met and sends notification to the terminal device via the D-channel packet exchange. Using a D-channel for signaling and switching is different from using a D channel for packet service/exchange. The D channel carries signaling and/or packet data information, at speeds up to 16 Kbits/second on basic rate service or Single Line ISDN Service, and signaling only information up to 64 Kbits/second for primary rate

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service, from the customer's premises to the central office. The D-channel has both data and signaling functionality (*see* http://www.qwest.com/products/data/isdn/isdn_faq.html). Shobu makes use of the D-channel's signaling functionality while the claimed invention uses the notification means to notify that the D-channel is to carry a certain amount of data information. Also, the claimed invention will conduct both the calling and transmission using the D-channel packet exchange depending on the volume of data present.

Therefore, Applicant respectfully submits that the Shobu reference cited above by the Examiner fails to teach or suggest all of the claim limitations as set forth in independent claims 1, 7, and 12. Applicant submits that dependent claims 2, 3, 4, 5, 8, 9, 10, and 11 are patentable at least by virtue of their dependency. Specifically, Shobu does not automatically transmit a large volume of data and regardless of the amount of data present, Shobu waits on an answer from the ISDN side (*see*, col. 3, ln. 54-55, Shobu). After the D-channel has been used to provide a signal, the two B channels are used in data transmission (*see*, col. 3, ln. 48-50, Shobu). A D-channel is normally used for signaling and switching but can also be used for low speed data packet service/exchange. The Examiner appears to be blending these two concepts together, when they are separate and distinct. The Examiner is therefore respectfully requested to withdraw the 102 rejection.

B. Rejections under §103.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Shobu in view of Corrigan et al. (U.S. Patent No. 5,966,636, hereinafter "Corrigan"). The Examiner

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correctly concedes that Shobu fails to teach a necessary data transmission time. The Examiner cites Corrigan to make up for this particular deficiency. However, the Examiner's rejection is not supported because Corrigan does not teach a necessary data transmission time but teaches time division multiplexing to provide more channels (*see*, col. 1, ln. 19-22, Corrigan). The data transmission time of the claimed invention does not affect the amount of channels available on one frequency but it determines whether data transmission will be sent. By contrast, Corrigan teaches data transmissions sent in time slots in which a communications unit may be assigned a particular time slot only for a limited amount of time (*see*, col. 1, ln. 27-31, Corrigan). There is no determining factor such as a necessary data transmission time to tell whether the data transmissions will be sent as in the claimed invention. The Examiner is therefore respectfully requested to withdraw the § 103(a) rejection from dependent claim 6.

According to Corrigan, the frequencies used by the communications system are divided into time slots which are structured with respect to the digital messages that they carry (*see* col. 2, ln. 59-61, Corrigan).

Claims 2, 3, 8, and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shobu in view of Yoshida (U.S. Patent No. 5,594,867, hereinafter "Yoshida"). As discussed above, Applicant submits that dependent claims 2 and 3 are patentable at least by virtue of their dependency on independent claim 1.

Dependent claims 4 and 10 stand rejected under 35 U.S.C. § as allegedly being unpatentable over Shobu in view of Yoshida, and further in view of Gregory (U.S. Patent No.

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5,909,673, hereinafter "Gregory"). As discussed above, Applicant submits that claims 4 and 10 are patentable at least by virtue of their dependency on independent claims 1 and 7, respectively.

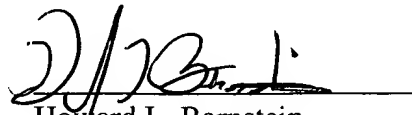
Claims 5 and 11 stand rejected under 35 U.S.C. § as allegedly being unpatentable over Shobu in view of Gregory. As discussed above, Applicant submits that claims 5 and 11 are patentable at least by virtue of their dependency on independent claims 1 and 7, respectively.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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CUSTOMER NUMBER

Date: February 20, 2004